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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,055	10/11/2001	Takeshi Shimizu	028918.01	7629

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/974,055	SHIMIZU ET AL.	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 27 June 2002.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 6/27/02 to the application filed on 10/11/01 which is a continuation of the application 08/938,973 filed on 9/26/97, now US Pat No. 6,374,271.
2. Claims 1-14 are pending in the case. Claims 1, 6, 10, 13 are the independent claims.
3. The objections of claims 10-12 as including informalities have been withdrawn in view of Applicants' amendment.
4. The obviousness type double patenting rejections of claims 1-3, 6-7, 10-13 as being unpatentable over claims 1-6, 20-22 of U.S. Patent No. 6,374,271 have been withdrawn in view of the terminal disclaimer submission.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al. (US Pat No. 6,029,182, 2/22/00, 10/4/96).

Regarding independent claim 1, Nehab discloses:

- a user interface (col 4, lines 40-57)
- a memory (abstract, col 4, lines 30-35)
- a goal outline *comprising organization of document information content (figure 3A and col 6, lines 20-38, the tree structure of the homepage site #21 shows the organization of the homepage content)*
- a presentation outline (col 3, lines 15-32, 45-49, the various layout formats of personalized documents)
- a linking between the goal outline and the presentation outline to create a document based on user inputs (col 3, line 50 to col 4, lines 1-39, link the layout format and the data to create *personalized documents*)
- authoring a document (abstract; col 3, lines 15 to col 4, lines 1-12, 40-45; col 8, lines 10-18, create and edit a *personalized document*)

Nehab does not explicitly disclose that the document authoring device comprises a controller coupled to the user interface and the memory that links the goal outline and the presentation outline. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include a controller coupled to the user interface and the memory that links the goal outline and the presentation outline because of the following reason. The fact that Nehab has the ability of creating a *personalized document* based on data structured in tree form retrieved from the websites and user-defined format suggests that Nehab performs linking these data and include a linking unit. Otherwise, a personalized document can not be created.

Regarding claim 2, which is dependent on claim 1, Nehab discloses that the user interface includes a display device, the controller displaying the goal outline display on the display device and generating the goal outline based on the input that relates to the goals outline display (col 3, lines 15-32, 50-65; col 4, lines 1-12, 40-45; figure 9B).

Regarding claim 3, which is dependent on claim 2, Nehab discloses:

- document prototype stored in the memory (col 8, lines 10-18, document templates store the formats of documents)
- instantiating the document prototype based on the input (user specifies a desired template (col 8, lines 10-18; col 4, lines 40-45)

Regarding claims 4 and 5, Nehab discloses linking between the document prototype to the card in the memory selected by the input, and generating a card and linking the card to the goals outline based on the input (col 3, lines 15-67 to col 4, lines 1-45, linking between the layout format and the data selected by the input for formatting a document).

Nehab does not use the same terminology: a card contained in the memory to store data information. However, as disclosed in the specification of the invention, a card is merely where to store data (page 5, lines 29-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include the cards for storing data contained in a memory since the web sites storing information data for creating documents in Nehab (col 4, lines 15-32) suggests the card database in the memory.

Regarding independent claim 6, Nehab discloses:

- storing data in a memory (abstract, col 4, lines 30-35)
- receiving an input through a user interface (col 4, lines 40-45; col 9, lines 62 to col 10, lines 1-6; figure 9A, col 14, lines 6-18)

Nehab does not explicitly disclose linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises organization of document information content and the document presentation outline comprises appearance characteristics.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises information content and the document presentation outline comprises appearance characteristic because of the following reason. *Nehab discloses the organization of the homepage content (figure 3A and col 6, lines 20-38, the tree structure of the homepage site #21 shows the organization of the homepage). The fact that Nehab has the ability of creating a personalized document based on data structured in tree form retrieved from the websites and user-defined format suggests that Nehab performs linking these data. Otherwise, a personalized document can not be created.*

Regarding claim 7, which is dependent on claim 6, Nehab discloses displaying a goals outline display on a display device and generating the goals outline based on the input that relates to the goals outline display (col 3, lines 15-32, 50-65; col 4, lines 1-12, 40-45; figure 9B).

Regarding claim 8, which is dependent on claim 7, Nehab discloses:

- generating a logical structure of the goals outline by instantiating a document prototype selected by the input (col 8, lines 10-18, document templates store the formats of documents)

- linking the instantiated document prototype to a card selected by the input (col 8, lines 10-18; col 4, lines 40-45)

Regarding claim 9, which is dependent on claim 8, Nehab does not disclose:

- generating a card
- linking the card to the goals outline based on the input

Nehab, instead, discloses linking between the data in the URLs list selected by the input and the logical structure of a document for formatting a document (col 3, lines 15 to col 4, lines 1-45, figure 9B, data stored in the URLs listed in the container content).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nehab to include generating a card and linking the card to the goals outline based on the input because of the following reason. As disclosed in the specification, a card is merely where to store data (page 5, lines 29-33). Therefore, the data, which is stored in a URL, is considered as equivalent to a card, is linked to the logical structure of the document (figure 9B, the multiple column of the document is selected for generating a document).

Independent claim 10 includes the same limitations as that of independent claim 6, and is rejected under the same rationale. Independent claim 10 further includes:

- receiving external information by the controller
- generating a card based on the external information
- storing the card as data in the memory

As mentioned above in independent claim 6, Nehab discloses receiving an input through a user interface (col 4, lines 40-45, col 9, lines 62 to col 10, lines 1-6; figure 9A, col 14, lines 6-18, data included in a formatted web document is received as a user input in the URL field on the user interface).

Nehab also discloses generating a card based on the external information (col 3, lines 15 to col 4, lines 1-45, format the data for a personalized document based on a user defined formatting commands where the commands are considered as external information entered by the user).

Nehab does not disclose storing the card in the memory. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have incorporated the storing step into Nehab since it was well known in the art that the data after created should be stored in a memory for later use.

Regarding claims 11 and 12, which are dependent on claim 10, Nehab discloses:

- generating an imported card step accepts the external information already in a desired card structure as the imported card (col 3, lines 30-49, the data from the web sites and the stored format information is applied for formatting a personalized document)
- generating an imported card step translates the external information into a desired card structure (col 3, lines 50-65, formatting a personalized document based on the data from the *user defined* Web site address information, *user defined* Web site commands and *user defined formatting commands* implies that

data from the external information is not in a desired format and so said data needs to be translated into a desired form based on the user defined formatting commands)

8. Claims 13-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer et al. (US Pat No. 5,347,628, 9/13/94).

Regarding independent claim 13, Brewer discloses:

- receiving inputs through a user interface (abstract, figure 2, col 3, line 62 to col 4, lines 1-20)
- displaying on the display device a meta-level display (figure 2, meta-level display – office-desk-drawer-files)

Brewer does not disclose explicitly linking a goal outline *comprising organization of document information content* to a presentation outline based on the input and the data.

*Instead, Brewer discloses the organization of the office content which includes a desk, a cabinet, and a trash can wherein the cabinet includes drawers, and the desk includes drawers containing files, and a desktop, a calendar, and an in/out basket (figures 1-3).*

*Brewer also discloses the presentation of the office with the positions of the desk, the cabinet, and the trash can. Brewer's disclosures, therefore, suggest the goal outline, which is the organization of the content of the office, and the presentation outline, which is the presentation of the office.*

*The fact that when a user wants to work with the files in the drawer, the user can put the cursor on the drawer to pull the drawer open until the files that he/she is interested in appears in the window (col 3, line 62 to col 4, lines 1-20 and figure 3) shows linking the organization of the office and the presentation of the office based on the input and the data.*

Brewer does not explicitly disclose the storing of data in the memory. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Brewer to include storing data in the memory since conventionally, the data when created should be stored in a memory for later use.

Regarding claim 14, Brewer discloses that the meta-level display is one of a kitchen image, an office image, and a studio image (figure 2, this is an office image includes a meta-level display of an office-desk-drawer-files display).

#### ***Response to Arguments***

9. Applicant's arguments filed 6/27/02 have been fully considered but they are not persuasive.

Applicants state that claims 1, 6, 10, 13 are amended to clarify the nature of the goal outline, which organizes the information of a document in a logical manner supported in the specification (page 2, 13-22).

However, nowhere in this passage discloses that the goal outline organizes the information of a document.

Applicants argue that figure 9B of Nehab does not disclose an organization of document information content but a URL list of information for a web page.

Examiner agrees.

However, figure 3A of Nehab discloses an organization of document information content (the tree structure of the homepage for site #1 shows the organization of the homepage content).

Applicants argue that Nehab does not disclose or suggest linking the goal outline to the document presentation outline based on the input and the data of authoring the document and Nehab does not need a controller to perform such linking.

Examiner disagrees.

The fact that Nehab has the ability of creating a *personalized document* based on data structured in tree form and retrieved from the websites and user-defined format suggests that Nehab performs linking these data. Otherwise, a personalized document can not be created.

Since the controller is for linking and Nehab suggests such linking, Nehab suggests including a controller as claimed.

Regarding claim 3, Applicants argue that Nehab does not disclose or suggest a controller generating a logical structure of the goal outline as recited. Applicants further argue that the document prototype is part of the goal outline, and since Nehab does not disclose or suggest a goal outline, Nehab does not disclose *any goal outline document prototype*.

Examiner disagrees.

Claim 3 recites that “wherein the memory contains at least one document prototype, the controller generating a logical structure of the goal outline by instantiating the document prototype selected by the input.”

It is clear that the document prototype is *not part of the goal outline* as argued. Instead, the document prototype, since contained in the memory as claimed, is part of the memory. Therefore, the request of disclosing a goal outline document prototype in Nehab is totally incorrect.

In addition, the document prototype, by definition, is a document model or a typical document. Therefore, the template in Nehab which specifies the typical layout of a document is considered as a document prototype.

Regarding claims 4 and 5, which are dependent on claims 3 and 4 respectively, as mentioned above, the Applicants’ argument is not correct. Therefore, Nehab does recite the feature of claim 3, and also of claims 4-5.

Applicants argue that Nehab has no disclosure of a card or any disclosure of an instantiated document prototype to link with information contained in memory.

Applicants further states that the assertion in the office action that a card is merely where to store data is incorrect according to the specification (page 5, lines 29-31).

Examiner disagrees.

The specification that discloses the card (page 5, lines 29-33) recites:

"The cards in the card database 106 are information elements (called points) on which the document being authored is based. That is, the cards contain the actual hypermedia information such as video, sound or text that make up the document."

It is clear that the card is where to store data since the card contain the actual hypermedia information such as video, sound or text.

Regarding claim 6, which is dependent on claim 1, Applicants' argument that Nehab fails to disclose the feature of claim 1, and so, fails to disclose the feature of claim 6 accordingly is not persuasive since Nehab discloses the feature of claim 1 as argued above.

Regarding claims 7-10, which are dependent on claims 2, 3, 5 , Applicants' argument that Nehab fails to disclose the feature of claims 2, 3, 5, and so, fails to disclose the

feature of claims 7-9 accordingly is not persuasive since Nehab discloses the feature of claims 2, 3, 5 as argued above.

Regarding claims 13-14, Applicants argue that in the meta-level display of Brewer, the calendar for planning is not a goal outline which comprises organization of document information content, and the desktop icon is not a presentation outline. Applicants further argue that the office action is a hindsight reconstruction of Brewer based solely on Applicants disclosure.

Examiner agrees that the calendar is not the goal outline and the desktop is not a presentation outline.

However, claim 13 recites a meta-level display, and claim 14 clarifies that the meta-level display is one of “a kitchen image, an office image, and a studio image.” Brewer discloses a meta-level display which is an office image (figure 2, meta-level display – office-desk-drawer-files).

Brewer further discloses *the organization of the office content* which includes a desk, a cabinet, and a trash can wherein the cabinet includes drawers, and the desk includes drawers containing files, and a desktop, a calendar, and an in/out basket (figures 1-3). Brewer also discloses *the presentation of the office* with the positions of the desk, the cabinet, and the trash can. Brewer’s disclosure, therefore, suggest the goal outline, which is the organization of the content the office, and the presentation outline, which is the presentation of the office.

The fact that when a user wants to work with the files in the drawer, the user can put the cursor on the drawer to pull the drawer open until the files that he/she is interested in appears in the window (col 3, line 62 to col 4, lines 1-20 and figure 3) shows linking the organization of the office and the presentation of the office based on the input and the data.

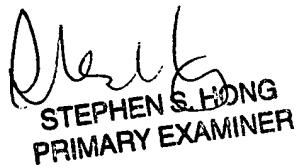
### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh  
9/28/02



STEPHEN S. HONG  
PRIMARY EXAMINER